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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

TUCKER, PHILIP C

ART UNIT	PAPER NUMBER
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1712

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DATE MAILED: 04/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	501559	Applicant(s)	CHOWDHARY
Examiner	P. TUCKER	Group Art Unit	1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 2/19/02
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1 - 40 is/are pending in the application.
- Of the above claim(s) 12-26, 33 and 40 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1 - 11, 27-32, 34-39 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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DETAILED ACTION

Claim Objections

1. Claim 2 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Guar splits must comprise polygalactomannan, thus claim 2 fails to further limit claim 1..

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 5-11, 27-30 and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rutenberg et al. (4269975).

Rutenberg teaches a method of preparing a ground guar which is made from hydrated guar splits (see abstract). Rutenberg teaches that extruding the guar, prior to grinding results in a gum which produces increased viscosity products (see Example II). Rutenberg also teaches that

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flaking of the guar prior to grinding, results in a product with higher viscosity than nonflaked guar (column 7, lines 4-20). Rutenberg differs from the present invention in that the use of both flaking and extruding, in the preparation of the ground guar is not disclosed. The courts have held, such as In re Crockett 126 USPQ 186, that combining such methods would not be patentable, since it would logically flow that the combination would produce the same effect, and would supplement each other. It would thus be obvious to one of ordinary skill in the art to utilize both extruding and flaking of the guar, in the process of making ground guar, given the teaching of Rutenberg that extruding and flaking produce superior ground guar from guar splits, than guar not subject to extruding or flaking. Rutenberg also differs in not specifying an extruding barrel of 2 - 8 inches, or the use of chemically or genetically modified guar. The utility of barrels of differing size, in order to optimize the processing of the guar would be an obvious variation to one of ordinary skill in the art (In re Rose 105 USPQ 237). The utility of chemically or genetically modified guar as an alternative to guar in the industrial uses disclosed by Rutenberg at column 1, lines 8-12 are well known, and would be obvious to one of ordinary skill in the art.

4. Claims 1, 3, 4, 27, 31, 32, 34, 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rutenberg et al. (4269975) in view of Dino (5646093), Harris (5990052) and Applicants specification.

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Rutenberg teaches a method of preparing a ground guar which is made from hydrated guar splits (see abstract). Rutenberg teaches that extruding the guar, prior to grinding results in a gum which produces increased viscosity products (see Example II). Rutenberg also teaches that flaking of the guar prior to grinding, results in a product with higher viscosity than nonflaked guar (column 7, lines 4-20). Rutenberg differs from the present invention in that the use of both flaking and extruding, in the preparation of the ground guar is not disclosed. The courts have held, such as In re Crockett 126 USPQ 186, that combining such methods would not be patentable, since it would logically flow that the combination would produce the same effect, and would supplement each other. It would thus be obvious to one of ordinary skill in the art to utilize both extruding and flaking of the guar, in the process of making ground guar, given the teaching of Rutenberg that extruding and flaking produce superior ground guar from guar splits, than guar not subject to extruding or flaking. The utility of chemically or genetically modified guar as an alternative to guar in the industrial uses disclosed by Rutenberg at column 1, lines 8-12 are well known, and would be obvious to one of ordinary skill in the art. In support of such knowledge in the art, Dino in Example 1, and Harris at column 8, lines 35-37 teach the use of guar splits to form chemically modified guar products which are used in operations such as oil well drilling and fracturing. Applicants specification at page 9, lines 15-27 clearly teach that it is known in the art to chemically modify guar gum, and genetically modify plants in order to produce the guar products, thus such variations would be obvious variations to one of ordinary skill in the art.

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5. Applicants arguments have been considered but are not deemed persuasive. With respect to the objection to claim 2, it is conceded that guar is not a polygalactomannan, but the guar splits must comprise polygalactomannan, and thus claim 2 does not further limit claim 1. With respect to applicants arguments that not all the steps of the claims art taught by Rutenberg, grinding and drying is taught at column 3, line 58 - column 4, line 5. Also hydrating, flaking, grinding and extruding are taught, for example, from column 4, line 50 - column 7, line 20. Moisture content and mesh size which are the same as the present invention are disclosed at column 4, lines 1-4 and lines 44-49. The scope of the invention is thus encompassed by Rutenberg. With respect to applicants arguments that the combination of flaking and extruding is not obvious over Rutenberg, although Rutenberg differs from the present invention in that the use of both flaking and extruding, in the preparation of the ground guar is not disclosed, the courts have held, such as in In re Crockett 126 USPQ 186, that combining such methods would not be patentable, since it would logically flow that the combination would produce the same effect, and would supplement each other. With respect to the rejection over Rutenberg et al. (4269975) in view of Dino (5646093), Harris (5990052) and Applicants specification, such was added for the sole purpose of rebutting the premise that the use of chemically or genetically modified guar was not known in the art, and as such is not considered a new rejection. It is clear from the cited patents and the specific teaching of applicants specification on page 9, that such is known in the art. An affidavit or declaration is not needed in view of the clear teaching of applicants specification and the prior art. The rejection is thus maintained.


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6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tucker whose telephone number is (703) 308-0529. The examiner's normal working hours are 7:30am-4:00pm, Monday-Friday. If necessary SPE Robert Dawson may be contacted at 703-308-2340. For inquiries of a general nature call the receptionist at 703-308-0651. The group FAX no. is 703-872-9310. The **after final** fax no. is 703-872-9311.

PCT-2448
April 25, 2002


PHILIP C. TUCKER
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